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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO.  |
|---|-------------|------------------------|---------------------|-------------------|
| 09/760,819  | 01/17/2001  | Christopher J. Stanley | PM 275510 P5642US   | 5588              |
| 909   | 7590        | 03/30/2004             | EXAMINER            |                   |
| PILLSBURY WINTHROP, LLP<br>P.O. BOX 10500<br>MCLEAN, VA 22102 |             |                        |                     | LU, FRANK WEI MIN |
|   |             | ART UNIT               |                     | PAPER NUMBER      |
|   |             | 1634                   |                     |                   |

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/760,819

Applicant(s)

STANLEY, CHRISTOPHER J.

Examiner

Frank W Lu

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2.  The proposed amendment(s) will not be entered because:  
(a)  they raise new issues that would require further consideration and/or search (see NOTE below);  
(b)  they raise the issue of new matter (see Note below);  
(c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached office action.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1 and 3-22.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.  
8.  The drawing correction filed on \_\_\_\_\_ is a)a) approved or b) disapproved by the Examiner.  
9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.  
10.  Other: \_\_\_\_\_

## **ADVISORY ACTION**

1. The proposed amendments filed on March 8, 2004 have been fully considered but will not be entered because:(1) they raise new issues that would require further consideration and/or search; and (2) they present additional claims without canceling a corresponding number of finally rejection claims.

### ***Response to Arguments***

I. In page 7, first paragraph bridging to page 9, first paragraph of applicant's remarks, applicant argues that the objections on claims 1, 3, 7-11, 20, and 22 have been overcome by the amendments of claims 1, 3, 7-11, 20, and 22 as suggested by the Examiner.

This argument has been fully considered and is moot since applicant has amended claims 1, 3, 7-11, 20, and 22 (see claims 1, 3, 7-11, 20, and 22 in the applicant's remarks). The new amendments in claims 1, 3, 7-11, 20, and 22 raise new issues that would require further consideration and/or search.

II. In page 9, third paragraph of applicant's remarks, applicant argues that the amendment on claim 7 has overcome the rejection under 35 USC 112, second paragraph.

This argument has been fully considered and is moot since applicant has amended claim 7 and added the phrase "at least one of the moieties is attached to the primer by a covalent linkage formed between one of the two vinyl groups of a divinyl sulphone molecule of the at least one moiety and a reactive functionality on the primer" into claim 7. The new amendment in claim 7 raises new issues that would require further consideration and/or search.

III. In page 9, fifth paragraph bridging to page 10, second paragraph of applicant's remarks, applicant argues that the amendments on claims 8 and 13 have overcome the rejection under 35 USC 112, second paragraph because the amended claims 8 and 13 do not lack antecedent basis.

This argument has been fully considered and is moot since applicant has amended claims 8 and 13. The new amendments in claims 8 and 13 raise new issues that would require further consideration and/or search.

IV. In page 10, third paragraph bridging to page 11, first paragraph of applicant's remarks, applicant argues that the amendments on claims 14-16 have overcome the rejection under 35 USC 112, second paragraph because the amended claims 14-16 are not vague and indefinite.

This argument has been fully considered and is moot since applicant has amended claims 14-16. The new amendments in claims 14-16 raise new issues that would require further consideration and/or search.

V. In page 11, second and third paragraphs of applicant's remarks, applicant argues that the amendment on claim 18 has overcome the rejection under 35 USC 102 (b).

This argument has been fully considered and is moot since applicant has amended claim 18 by changing the phrase "a carrier macromolecule" into "a non-nucleotide carrier macromolecule". The new amendment in claim 18 raises new issues that would require further consideration and/or search.

VI. In page 11, fourth and fifth paragraphs of applicant's remarks, applicant argues that the amendment on claim 21 has overcome the rejection under 35 USC 102 (b).

This argument has been fully considered and is moot since applicant has amended claim 21 by adding a word “directly” into the claim. The new amendment in claim 21 raises new issues that would require further consideration and/or search.

VII. In page 13, last paragraph bridging to page 14, first paragraph of applicant’s remarks, applicant argues that the amendments on claims 1 and 3 have overcome the rejection under 35 USC 102 (e).

This argument has been fully considered and is moot since applicant has amended claim 1 by changing the phrase “wherein said carrier macromolecule is a natural or synthetic polysaccharide, homopolyamino acids or a synthetic polymer having nucleophilic functional groups” into “wherein said carrier macromolecule is a water soluble a temperature in the range of 0-60°C” and has amended claim 3 by changing the phrase “wherein said carrier macromolecule is a dextran, a starch, an hydroxyethyl-starch, an hydroxypropyl-starch, a glycogen, an agarose derivative or cellulose derivative, or a natural gum” into “wherein said carrier macromolecule is a natural gum or a homopolyamino acid”. The new amendments in claims 1 and 3 raise new issues that would require further consideration and/or search.

VIII. In page 14, second paragraph bridging to page 16, third paragraph of applicant’s remarks, applicant argues that: (1) “there is no motivation, whether explicitly or implicitly, to combine the teachings of McCormick and Yamane to arrive at the presently claimed immobilized nucleic acids and methods using the same.”; and (2) “[N]either McCormick nor Yamane teaches a non-nucleotide carrier macromolecule that is directly bound to a solid support”.

These arguments have been fully considered and are moot since applicant has amended claim 21 by adding a word “directly” into the claim. The new amendment in claim 21 raises new issues that would require further consideration and/or search.

2. Regarding to newly added claim 23, since claim 23 has a phrase “at least one of the moieties is attached to the primer by a covalent linkage formed between one of the two vinyl groups of a divinyl sulphone molecule of the at least one moiety and a reactive functionality on the primer”, which has been added into claim 7 in the amendment filed on March 8, 2004, although newly added claim 23 has all limitations recited in claim 7, claim 23 has new issues that would require further consideration and/or search. Furthermore, applicant presents additional claims (new claim 23) without canceling a corresponding number of finally rejection claims.

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.



FRANK LU

PATENT EXAMINER

Frank Lu

PSA

March 24, 2004